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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/222,336
Filing Date: December 28, 1998
Appellant(s): STORY ET AL.

Michael E. Shanahan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 20, 2008 appealing from the Office action mailed August 11, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,926,624

KATZ et al.

7-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

Appellant canceled claims 34-36. Claims 1-8, 10-18 and 20-33 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8, 10-18, 20-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 11, 21, 31 recites “creating a first license comprising a first cardinality, wherein the cardinality indicates the number of playback devices that can be authorized for playback of associated digital audio content”. Applicant’s specification teaches creating a first license having an associated cardinality that determined the number of playback devices that can be authorized by the license. Also the specification teaches the license is comprised of 32 bit group ID, or other identifier size. Further the specification discloses that each playback device storing a license belongs to a set of one or more playback devices storing the license, and the set being authorized to play the content. The license does not comprise of cardinality according to applicant’s disclosure: the license is associated with the cardinality by authorizing each device storing the identifier (license) to play content that include the same identifier (license). The number of devices that are authorized to play the content (cardinality) is associated with the

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license. Since the specification does not teach the “license comprising of cardinality”, it is considered new matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 10-18, 20-30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Katz et al. U.S. Patent No. 5,926,624.

Regarding claims 1-3, Katz teaches creating one or more licenses having cardinality associated with the license, the cardinality indicating the number of authorized playback devices (see col. 12 lines 39-67); transmitting the license, via network connection, to playback devices authorizing playback of the digital audio content with the playback devices (software or hardware) (see fig. 2, col. 11 line 32 to col. 12 lines 67); Katz teaches transmitting configuration data, which includes Group ID, storing the Group ID in the playback devices and authorizing only the playback devices defined by the Group ID (see col. 8 lines 5-62, col. 9 line 13 to col. 10 line 67 and col. 11 line 31 to col. 12 line 66); storing the license in digital audio contents, and determining whether playback of digital audio content is authorized to by comparing the first license with the digital content having the licenses embedded (see col. 13 lines 19-58). Katz teaches that the server (260) creating a targeted header for selected files (the targeted header

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linked with the corresponding digital information), the header comprises a combination of the descrambling map with the private player IDs corresponding to the targeted playback devices etc. (see col. 13 line 30 to col. 14 line 27), storing a first license in second digital audio content and authorizing playback of the second digital audio content with the first set of playback devices; creating a second license having a second cardinality ... (see col. 12 lines 55-64).

Regarding claims 4-6, 14-16 and 25-27, Katz teaches wherein the cardinality is fixed (see col. 11 lines 32-53); variable or unlimited (see col. 12 lines 39-67).

Regarding claims 7, 8, 17, 18, 28 and 29, Katz teaches playback devices comprising a hardware or software devices (see col. 11 lines 19-31 and col. 15 lines 30-62).

Regarding claims 10, 20 and 30, Katz teaches the digital content comprises of video digital programming (see col. 5 lines 45 to col. 6 line 3 and col. 18 line 66 to col. 19 line 4).

Claims 11-13 and 21-23 are rejected as stated above in claims 1-3 respectively.

Claim 24 is rejected as stated above in claim 1.

Regarding claims 31-33, Katz teaches receiving a first license (Group ID) at a playback device, the playback device belonging to a first set of playback devices; (player or group ID), the license comprising (having associated) a first cardinality, wherein a cardinality indicating a number of playback devices that can be authorized for playback of digital content, wherein the first set of playback devices is less than or equal to the first cardinality; storing the first license in the playback device; receiving first digital content, wherein information associated with the first license is embedded in the in the first digital content; and determining whether playback of the received first digital content by the playback device is authorized by comparing the first license stored in the playback device with the first license information embedded in the first digital

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content; (see col. 8 lines 5-62, col. 9 line 13 to col. 10 line 67 and col. 11 lines 32-53 and col. 12 lines 24-66).

(10) Response to Argument

Regarding the 112 rejection, Appellant explains that the specification on page 11 teaches "In operation, license management device 510 creates a license having a cardinality." Appellant also explains that, appellant's specification, page 12, line 9 to page 13, line 20 explains that the *license itself has a cardinality component*, with the cardinality feature of each license being enforced by a licensing management device, which would not be possible if the license itself did not include a cardinality component. Further, appellant points out that the license is generated in response to a user request and prior to that request, the cardinality of that license cannot be known, and thus the cardinality is generated as part of the license creation process.

As indicated by Appellant, Appellant's specification teaches as follows.

License management device 510 enforces the cardinality restrictions of the licenses created. In one embodiment, license management device 510 causes licenses to be stored by playback devices by issuing one or more commands to the playback devices to which the licenses are targeted. In one embodiment, the commands are encrypted and/or signed to prevent cloning. License management device 510 can also cause the license to be included in digital content in a similar manner. Alternatively, license management device 510 can communicate the creation of a license to an appropriate content provider that, in turn, includes the license in digital content.

In one embodiment, **the license comprises a 32 bit group identifier; however, other identifier sizes can also be used. Thus, each playback device storing a license belongs to a set of one or more playback devices storing the license. The set of playback devices is authorized to play digital content that includes the license.** Multiple licenses can be granted for any digital content. For example, a corporation having 100 employees, each having a playback device, can obtain a license having a cardinality of 100 to authorize each employee to play digital content obtained by the corporation. An individual can obtain a license with a cardinality of one for personal use of digital

As indicated above, the specification does not teach that the "license", which could be a 32 bit group identifier, specifies cardinality (number of devices that can play the content).

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Contrary to Appellant's argument, the cardinality (number of devices that can play the content) is controlled by authorizing playback devices that include this "bit identifier" (license) to play the content. Therefore, as disclosed by Appellant, the devices that include the license (32 bit group identifier) indicate the number of cardinality for that content. If one device includes such identifier, then the cardinality is one if three devices include the identifier, the cardinality is three. In short the number or the cardinality is determined by the number of playback devices that are authorized to play the content i.e. which have the "bit identifier".

If the license (32 bit Group ID) has a cardinality component, as indicated by Appellant, however it is not taught or discloses where in that identifier is the cardinality component. In short for the license to consist of cardinality, the specification does not teach which part of the 32 bit Group ID or how the 32 bit Group ID provides indication of how many devices are authorized.

Therefore, claim 1 contains subject matter (the license (32 bit Group ID) comprising of cardinality) which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Appellant argues "(b)ecause the Examiner has impermissibly inserted words into and/or changed the meaning of the claims on appeal, the rejection with respect to Katz must therefore fail on this basis alone (*i.e.*, because the Examiner's rejection is based on a flawed interpretation and/or is based on terms not present in the pending claims. Thus, the pending rejection is, in fact, not based on the claims actually pending in this appeal). Accordingly, appellant's request that the rejection under 35 U.S.C. § 102(e) be withdrawn". Examiner agrees that for example the

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independent claim 1 recites "creating a first license comprising a first cardinality" and transmitting the first license to a first set of playback devices, storing the first license in the devices and authorizing by comparing the license with the digital audio content having the embedded license. However as indicated in the Appellant's disclosure the license, whether it includes or comprises of a cardinality, is a bit identifier (for example a 32 bit identifier). Based on this interpretation Katz also teaches a bit identifier, in which the identifier is created, transmitted and stored. Same as Appellant's claimed invention, the playback devices are authorized by comparing the bit identifier with the digital audio content having the embedded bit identifier.

Appellant argues that Katz discloses a digital library and a mobile playback device that can be used to play digital content from the digital library (see, for example, Fig. 2. Katz discloses that playback devices can be members of one or more groups and include a group ID. See Katz, col. 12, lines 39-67), *however, the Group ID of Katz is merely a number that identifies a group*. Appellant argues that *the Group ID does not indicate a number of playback devices in the group nor does it provide any restriction on the content a particular device may play*, thus, Katz fails to show or suggest a license comprising a cardinality as specified in appellant's pending claims.

As indicated before appellant's specification teaches (see page 12) the **license comprised of 32 bit group ID, or other identifier size**. Further the specification discloses that each playback device storing a license belongs to a set of one or more playback devices storing the license, and the set of playback devices are authorized to play the digital content, which is the same as Katz's system.

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Katz teaches a license management device (Server 260) generating a license (Group ID) and the license transmitted to playback devices (see fig. 2& 10, col. 8 lines 30-63 and col. 12 lines 39-67). Katz further teaches the library server 260 utilizes a set of identifiers (i.e. player ID) for mobile playback devices authorized to receive the selected download data from the library, the library formatting the downloads data that can only be read by mobile devices with these identifiers (see col. 11 lines 39-48). Katz also teaches playback devices logically grouped together using a Group ID and digital information content, software, or configuration data changes targeted to a group of mobile playback devices defined by a group ID. Each Player storing one or more group ID of which the particular player is a member, playback devices of the same group share the same Group ID (see col. 12 lines 39-66). Players with the same Group ID, indicates the number of playback devices that are authorized to playback the content (cardinality).

Appellant's argument is that *the Group ID of Katz is merely a number that identifies a group and the Group ID does not indicate a number of playback devices in the group nor does it provide any restriction on the content a particular device may play*. Examiner would like to point out that in Katz the "cardinality" (number of playback devices authorized), is provided by the Group ID, same as Appellant's claimed invention. However, if the Group ID of Katz is not the same as Appellant's 32 bit Group ID, which is the license, Appellant have never indicated which part of the license is considered "cardinality" to patentably distinguish it from the prior art (Katz). Examiner understanding of the association of the license and the cardinality is that every playback device that has the license indicates the cardinality. Appellant's 32 bit Group ID is the

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same as Katz's group ID which indicates the number of playback devices that are authorized to play a content.

Therefore, Katz's *Group ID* indicates a number of playback devices in the group and provides restriction on the content a particular device may play, since only the devices which have the group ID are authorized to play a content.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

YR

/Yehdega Retta/

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